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09/839,433	04/20/2001	Claude Jarkae Jensen	10209.56	1737

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/839,433

Applicant(s)

JENSEN ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,7,8,11,12,22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7,8,11,12,22 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1616

### **DETAILED ACTION**

Receipt of Request for Continued Examination and Amendments received February 7, 2005 is acknowledged. Claims **1, 7-8, 11-12, 22, and 27** are pending in this application. Claims 2-6, 9-10, 13-21, 23-26, and 28-30 stand cancelled.

#### ***Request for Information under 37 CFR 1.105***

Morinda Inc. introduced a lip balm in 1999 containing noni (*Morinda citrifolia*) and constitutes prior art. However, the exact composition of the lip balm is not disclosed on the website. Thus, since both the prior art and the instant application same the same assignee, Morinda Inc., and the advertisement might possibly constitute prior art under 102, the examiner requests that the applicant provide any information available concerning the components in the lip balm for the record.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 27 is directed to the composition of claim 1 that further contains ingredients selected from a Markush group. However, the claim also recites “each present in an amount between about 0-1”. This is vague and indefinite since the claim requires that composition

Art Unit: 1616

further contain one of the ingredients listed in the group. Thus, it is not possible to have the ingredient in an amount of 0%. Further clarification is requested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 7-8, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen et al (6,589,514).**

The applied reference has a common Morinda Inc. with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Example 1 discloses a composition contains 30-40% *Morinda citrifolia* juice, 1-5% *Morinda citrifolia* oil, 1-5% cetyl alcohol, 5-10% octyl methoxycinnamate, and 0-1% fragrance, among other components.

Note that the recitation “lip treatment” is not given patentable weight since it does not impart a structural limitation on the claims.

***Claim Rejections - 35 USC § 103***

Art Unit: 1616

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 7-8, 11, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998-2003) by itself or in view of JP2000-095663 to Kondo et al.**

Tahitian Noni discloses that noni (*Morinda citrifolia*) products combine the benefits of Tahitian noni juice and Tahitian noni oil that nourishes the skin at the cellular level. The cite states that the noni juice delivers soothing and renewing benefits to the skin and the oil contains linoleic acid and essential fatty acids to nourish the skin and dry spots (Note Tahitian Noni essential oil). The reference teaches an SPF lip balm containing noni oil. Lastly, the reference teaches the combination of the juice and oil in Tahitian Noni Skin Supplement and Body Balance Cream.

The reference does specify percentages of the oil and juice in the topical formulation.

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit, roots, or other dry matters. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, lipstick, shampoo, and conditioner. See page 2.

Art Unit: 1616

Although the Noni products fail to disclose the amount of the *Morinda citrifolia* juice and oil, the mere difference in concentration as the sole criteria for patentability for subject matter encompassed by the prior art is not supported in the absence of unexpected data. See MPEP 2144.05. Furthermore, since the Noni lip balm contains the same critical ingredients for the same functional purpose and absent the applicant's demonstration of the criticality to the concentration of the components, it is deemed that concentration is a manipulatable parameter known to those skilled in the art at the time the invention was made.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the teaching of Kondo et al and utilize the instant range of the *Morinda citrifolia*. One would have been motivated to do so since Kondo et al teach cosmetics such as a lipstick or face cream containing *Morinda citrifolia* in the instant range. Further, Kondo teaches the medicinal extract is obtained from any part of the plant. Thus, one would have been motivated to utilize the instant range with the expectation of similar results.

#### ***Response to Arguments***

Applicant argues that the recitation "lip treatment" overcomes the use of Tahitian Noni Advertisement as prior art since the products are directed to body creams. Applicant argues that the body Balance Cream in the Advertisement does not render the instant invention obvious since the formulation is not for the lips. It is argued that "lips are not really skin" and thus skin products are not suited for the skin.

Applicant's arguments filed 2/7/05 have been fully considered but they are not persuasive. Firstly, it is pointed out that applicants' claims are directed to a composition. Thus, argument that the instant composition is intended for lip treatment is considered a intended use

Art Unit: 1616

recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In instant case, the preamble and intended use is given weight to the extent that the composition must be capable of being applied to the skin and is non-toxic. The prior art's composition clearly is non-toxic and is applied to the skin. Thus, the prior art is capable of being applied to the lips. Secondly, it also should be noted for the record that Tahitian Noni does in fact specifically teach a lip balm.

Additionally, the examiner points out that the website Advertisement clearly states, "Morinda proprietary formula combines the benefits of the raw Tahitian Noni Juice and Tahitian Noni oil." Therefore, the components of the cosmetic composition such as the lip balm and body balance cream are given. The only deficiency of the prior art is the concentration and absent the criticality of applicant's range, it is deemed an obvious parameter since the prior art composition are utilized for same purpose as applicant: topical application.

For the reasons stated above, the rejection is maintained.

**Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998-2003) in view of Pelle et al (6,136,301).**

Art Unit: 1616

Tahitian Noni discloses that noni products combine the benefits of Tahitian noni juice and Tahitian noni oil that nourishes the skin at the cellular level. The cite states that the noni juice delivers soothing and renewing benefits to the skin and the oil contains linoleic acid and essential fatty acids to nourish the skin and dry spots (Note Tahitian Noni essential oil). The reference teaches an SPF lip balm containing noni oil. Lastly, the reference teaches the combination of the juice and oil in Tahitian Noni Skin Supplement and Body Balance Cream.

The reference does specify percentages in the topical formulation.

Pelle et al teach a natural lip product for repairing chapped, cracked lips (col. 1, lines 10-25). Pelle teaches the use of free fatty acids (5-40%) such as oleic and palmitic acid since these are the primary naturally occurring free fatty acids in the stratum corneum (col. 3, lines 40-56). A wax base "known in the art" is formulated from waxes and oils. Waxes such as beeswax, ozokerite or paraffin and plant or animal oils are taught in the amount of 1-20% (col. 4, lines 38-41). Sunscreens such as zinc oxide are taught. See column 5, line 1. Pelle teaches the use of active agents such as anti-irritants in the composition (col. 5, line 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tahitian Noni Products and Pelle et al and use the instant range. One would be motivated to look at the teachings of Pelle since Pelle et al provide the general guidance in formulating a moisturizing lip product with essential oils. Pelle teaches using natural oils containing essential fatty acids in the instant amount and Tahitian Noni teaches noni heals, soothes, and nourishes the skin and the oil contains fatty acids such as oleic and palmitic acids. Therefore, one would expect similar results using the instant range since both references teach moisturizing lip formulations with essential fatty acids.



Art Unit: 1616

Although the Noni products fail to disclose the amount of the *Morinda citrifolia* juice and oil, the mere difference in concentration as the sole criteria for patentability for subject matter encompassed by the prior art is not supported in the absence of unexpected data. See MPEP 2144.05.

### ***Response to Arguments***

Applicant argues that Noni-now teaches a body cream and “it is improper to rely on the non-toxic external use cream”.

The merits of Noni-now have been discussed above.

**Claims 1, 7-8, 11, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 to Kondo et al by itself or in view of Elkins (Hawaiian Noni, 1998).**

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit, roots, or other dry matters. The fruit is exemplified. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, **lipstick**, shampoo, and conditioner and in the form of a liquid, salve, gel, etc. See page 2 and examples. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components (paraffin, squalene, cetyl alcohol), antioxidants, surfactants, thickeners, astringents, UV absorbents (octyl methoxycinnamate), vitamins, etc. in the cosmetic compositions. See examples and page 4.

Art Unit: 1616

Examples teach the instant additives. It should be noted that linoleic acid and xeronine are inherent properties of *Morinda citrifolia*.

JP does not specify the part of the fruit utilized, i.e. the fruit seed oil or the fruit juice.

Although, JP does not specify the part of the *Morinda citrifolia* fruit utilized, it is deemed obvious to one of ordinary skill in the art to utilize any part of the *Morinda citrifolia* extract in the cosmetic composition. One would have been motivated to do so since JP teaches any part of the plant may be utilized and it will have the cosmetic benefits of skin whitening abilities, antioxidants effects, and antimicrobial effects. Therefore, one would have been motivated to utilize the fruit juice and oil for an additive effect.

Elkins teaches the usage of noni for over hundreds of years for its therapeutic actions (antimicrobial, antioxidant, and emollient benefits). Elkins teaches that *all* parts of the noni plant such as the fruit, the seeds (which contains the oil), bark, leaves, and flowers are utilized. See page 9-11. One of the most prevalent uses of noni is as a skin healing agent due to the presence of pro-xeronine and the skin's response to it. See page 30.

Furthermore, one would look to the teachings of the prior art, i.e. Hawaiian Noni and its uses of noni, and note that all the parts of the noni plant provide beneficial effects to the skin. Therefore, one would have been motivated to combine the various plant parts and expect an additive effect on the skin.

With regard to claim 11, one would be motivated to manipulate the concentration of the additive depending on the desired form, i.e. a cream, salve, stick, or ointment, of the cosmetic. This is viewed as a manipulatable parameter known to those skilled in the art.

### ***Response to Arguments***

Art Unit: 1616

Applicant's arguments filed 2/7/05 have been fully considered but they are not persuasive.

Applicant argues that the claims have been amended to "lip treatment" and thus overcomes the prior art. Applicant argues that neither reference teach all the limitations, in particular the weight percent of the oil and fruit juice respectively. Applicant teaches that Kondo (JP '663) does not teach the particular combination of noni oil and fruit juice. Applicant argues that Kondo teaches away from *Morinda citrifolia* and the exclusive use of it. Lastly, applicant argues that the instant claims are directed to a lip treatment and Kondo teaches all other forms of cosmetics.

Applicant argues that the secondary reference, Elkins, does not cure the deficiencies in Kondo. Applicant argues that Elkins does not teach the specific use of noni oil and fruit juice or the use of *Morinda citrifolia* for lip care.

Firstly, it is pointed out that applicants' claims are directed to a composition. Thus, argument that the instant composition is intended for lip treatment is considered a intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In instant case, the preamble and intended use is given weight to the extent that the composition must be capable of being applied to the skin and is non-toxic. The prior art's

Art Unit: 1616

composition clearly is non-toxic and is applied to the skin. Thus, the prior art is capable of being applied to the lips.

Secondly, it also should be noted for the record that Kondo teaches cosmetic forms such as lipstick that are applied to the skin. See page 2.

With regard to the weight percent of the extract, the examiner points out that Kondo teaches the use of the extract in an amount of 0.0005-5%, which falls within the claimed range.

With regard to the argument that the instant invention is exclusively made of the extract (oil and juice), the examiner points out that the applicant is relying on features that are not claimed. The instant claims language is open to other components in the formulation. Moreover, the dependent claims require additives in the range of 20-80%. Therefore, this argument is perplexing since the claims also utilize and require conventional additives like Kondo and is not made of the extract exclusively.

The examiner recognizes that Kondo does not specify the instant combination and thus the rejection is made under obviousness. However, Kondo does provide adequate motivation to utilize all parts of the plant and most preferably the fruit. The examiner points out that the fruit contains both the fruit juice and the seeds containing the oil.

The examiner relies on the secondary reference to teach the conventional use of all parts of the plant without distinction, for medicinal purposes including the use of *Morinda citrifolia* for skin healing purposes since it has emollient benefits.

Absent the unexpectedness of using the instant combination in the instant weight ratio, the examiner maintains the rejection since Elkins clearly teaches the state of the art wherein all parts of the noni plant have been used for many years prior to the instant invention.

Art Unit: 1616

The examiner again points out that the applicant has not provided any unexpected results to overcome the instant rejection.

Accordingly the rejection is maintained.

**The rejection of claims 11-12 and 22 are under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 to Kondo et al by itself or in view of Elkins (Hawaiian Noni, 1998) in further view of Lane (5,503,825) is maintained.**

JP teaches a plant extract such as Morinda citrifolia for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant Morinda citrifolia in the amount of 4.8%. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit, roots, or other dry matters. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, lipstick, shampoo, and conditioner. See page 2. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components, antioxidants, surfactants, thickeners, astringents, UV absorbents, vitamins, etc. in the cosmetic compositions. See examples and page 4. Examples teach the instant additives.

\*It should be noted that linoleic acid and xeronine are inherent properties of Morinda citrifolia.

Elkins teaches the usage of noni for over hundreds of years for its therapeutic actions (antimicrobial, antioxidant, and emollient benefits). Elkins teaches that all parts of the noni plant such as the fruit, the seeds, bark, leaves, and flowers are utilized. See page 9-11. One of the most prevalent uses of noni is as a skin healing agent due to the presence of proxeronine and the skin's response to it. See page 30.

Art Unit: 1616

JP does not specify the instant additives (ozokerite) or the concentration of the white petrolatum.

Lane teaches a lip balm composition containing aloe and salt. Lane teaches conventional additives and vehicles for the inventive aloe/salt component. These conventional additives are petroleum, silicon oils, paraffin, beeswax, ozokerite, cetyl alcohol, isopropyl myristate, fatty acids, UV absorbers such as salicylic acid derivatives, derivatives of cinnamic acids, and benzophenone derivatives (col. 4, lines 15-62) and the form may be stick, salve, cream, or ointment. Example 2 teaches a lip balm base that contains 44% petrolatums, 0.1% lanolin, 0.5% cetyl alcohol, 1.5% padimate, and 1% isopropyl myristate.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the guidance provided by Lane and utilize the instant additives and concentrations. One would have been motivated to do since Lane teaches a conventional lip balm base known in the art and utilizes the *conventional* lip balm base with the inventive aloe/salt component. Therefore, although Kondo et al teach a lipstick composition but do not exemplify a lipstick, one would be motivated to look to the prior art and utilize a conventional lip base in combination with the “inventive concept”, i.e. the extract, with the expectation of similar results.

#### ***Response to Arguments***

Applicant argues the merits of Kondo and Elkins and argues that Lane does not cure the deficiencies of Kondo.

Applicant's arguments filed 2/7/05 have been fully considered but they are not persuasive. The merits of Kondo has been addressed above.

#### ***Double Patenting***

Art Unit: 1616

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 7-8, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,589,514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and US patent claim similar subject matter with obvious modifications.**

US patent claim 59 is directed to a repair composition containing 0.1-80% *Morinda citrifolia* juice, an active ingredient, and 0.1-5% *Morinda citrifolia* oil.

Instant application claim 1 is directed to a composition containing 0.1-50% *Morinda citrifolia* juice, 0.1-20% *Morinda citrifolia* oil for lip treatment.

Instant claim 1 is the broader composition and fully encompasses the scope of US patent claim 59. Thus, instant application would anticipate claim 59 in US '514.

Further, US patent claim 1 is directed to a repair treatment comprising: 0.1-80% *Morinda citrifolia* juice and a sun-screening element wherein octyl salicylate and octyl methoxycinnamate are listed in the Markush group. Dependent claim 14 recites 0.1-10% *Morinda citrifolia* oil.

Art Unit: 1616

Instant application claim 1 is directed to a composition containing 0.1-50% *Morinda citrifolia* juice, 0.1-20% *Morinda citrifolia* oil for lip treatment. Dependent claim 7 recites 1-5% octyl salicylate in a Markush group and dependent claim 8 recites 5-10% octyl methoxycinnamate in a Markush group.

Thus, the combination of claims 1 and 14 of US Patent yield a composition containing *Morinda citrifolia* juice, *Morinda citrifolia* oil, and octyl salicylate/ octyl methoxycinnamate. The combination of claim 1 and 7 or 8 respectively of instant application provide a composition containing *Morinda citrifolia* juice, *Morinda citrifolia* oil, and octyl salicylate/ octyl methoxycinnamate. Therefore, the instant claims and US patent claims are obvious modifications of each others.

### ***Conclusion***

None of the claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi  
Examiner  
Art Unit 1616

SSG

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**